

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action of the Examiner mailed September 20, 2005. Claims 1-17, 68-73, 75 and 77-86 remain pending. Claims 18-67, 74 and 76 have been canceled without prejudice, and claims 77-86 have been added. Reconsideration and reexamination are respectfully requested.

**Allowable Subject Matter**

Applicants thank the Examiner for indicating claims 4, 6-14, 16, 17, 67-70, and 73-76 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Rejection under 35 U.S.C. § 103(a)**

Claims 1-3, 5, 15, 71, and 72 are rejected as being unpatentable over Brodsky (US 4,910,503). The Examiner asserts that Brodsky teaches the device as claimed except for teaching the device being applied to an HVAC controller. The Examiner asserts that this feature is in the preamble without breathing life and meaning into the claim and is thus not accorded patentable weight. The Examiner also asserts that an HVAC system is one of many applications wherein the device of Brodsky might potentially be applied by one of ordinary skill in the art. Applicants respectfully traverse the rejection.

Independent claim 1, as amended, recites:

1. An HVAC controller comprising:  
two or more switches that control one or more HVAC parameters;  
a movable member;  
a first plurality of detents, wherein the first plurality of detents are  
configured to cause the two or more switches to be switched in a sequence when  
the movable member is moved.

Brodsky does not appear to teach such a controller. Brodsky appears to be directed to a joystick type device for providing X and Y coordinate analog input values and associated function selection to a computer performing a plurality of user functions. See, for example, column 2, lines 29-33 and column 3, line 64 through column 4, line 5. Brodsky does not appear to teach or

suggest an HVAC controller having two or more switches that control one or more HVAC parameters, as is now recited in independent claim 1.

The Examiner asserts that while Brodsky does not teach his device as being applied to an HVAC controller, "an HVAC system is one of many applications where the Brodsky device might be applied". Applicants respectfully disagree. As noted in MPEP § 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the present case, Applicants submit that there is no motivation, suggestion, or guidance in Brodsky for applying his multi-function input device to an HVAC controller, and more specifically, for controlling one or more HVAC parameters of an HVAC controller, as now recited in claim 1. In fact, absent Applicants' own disclosure, it is not clear how the Brodsky device would be applied to an HVAC controller. For these and other reasons, claim 1 as amended is believed to be clearly patentable over Brodsky. For similar and other reasons, dependent claims 2-17 are also believed to be clearly patentable over Brodsky.

Independent claim 71, as amended, recites a method for causing two or more switches to be switched in a sequence involving the steps of providing two or more switches, a movable member, and a plurality of detents, wherein the plurality of detents are configured to engage the two or more switches in a predetermined sequence when the movable member is moved, and wherein each switch is engaged by a different one of the plurality of detents. Brodsky does not appear to teach or suggest such method steps. Instead, Brodsky appears to teach a series of rotary detents formed by lobes 108 surrounded by lands 110, and roller tips 114 on arms 106' snapping from one detent position on one land over the adjacent lobe to the next adjacent land. See, for example, column 7, lines 53-68. Brodsky teaches "one tip 114 will ride up on a lobe 108 and closes its microswitch 112 before the other tip 114 rides up the same lobe 108 and closes its microswitch 112. See, for example, column 8, lines 3-8. Brodsky thus does not appear to teach a system whereby each switch is engaged by a different one of the plurality of detents, as recited in claim 71. Additionally, there is no motivation for one of ordinary skill in the art to modify Brodsky to achieve the claimed method. Withdrawal of the rejection is respectfully requested.

As noted above, the Examiner indicated that claim 67 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claim 67 has been rewritten in independent form as new claim 77, and claim 67 has been canceled without prejudice. New claim 77 is believed to be clearly in condition for allowance.

The Examiner further indicated that claim 74 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 74 has been rewritten in independent form as new claim 78, and claim 74 has been canceled without prejudice. The preamble for new claim 78 has also been modified slightly to more accurately define the method. New claim 78 is believed to be clearly in condition for allowance.

The Examiner also indicated that claim 76 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 76 has been rewritten in independent form as new claim 83, and claim 76 has been canceled without prejudice. The preamble for new claim 83 has also been modified slightly to more accurately define the method. New claim 83 is believed to be clearly in condition for allowance.

In view of the foregoing, all pending claims 1-17, 68-73, 75 and 77-86 are believed to be in condition for allowance. Reconsideration and examination are respectfully requested. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

Respectfully Submitted,

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